UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,671	12/24/2003	Kia Silverbrook	NPB008US	7891

24011   7590   03/22/2007
SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER
LE, KHANH H

ART UNIT	PAPER NUMBER
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 08 January 2007.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 8-11* is/are pending in the application.

   4a) Of the above claim(s) *8-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is responsive to the Correspondence filed January 08, 2007.
Claims 1 and 8 are amended. Claims 1-4, 8-11 are now pending.   Claims 1 and 8 are
independent.

Restriction by Original Presentation

2.   In the last Office Action, mailed 12/19/2006, a restriction by Original
Presentation was made as to all claims. In response, Applicants amended independent claim 1,
which overcomes the restriction requirement as to claim 1 and its dependents, but not
independent claim 8. This latter and its dependents still read on invention II, as defined in the
last office action, which is mutually exclusive of the originally presented Invention I.

To recap (please see last Office Action pages 2-6):

Original Invention I was directed mainly to a method and system of tracking user
interaction with a printed interactive publication using a sensing device and a computer system,
wherein the printing step is only one of the steps.

Invention II consisted mainly of a method and system for printing the interactive
publication, wherein the coded data is printed at the same time using a composited dot data and
wherein a first dot data for coded data, and second dot data for human-readable data are
generated in a printer, and composited together into said composited dot data, while all the
other steps of Invention I previously presented are canceled.

Since applicant has received an action on the merits for the originally presented invention
(invention I), this one has been constructively elected by original presentation for prosecution on
the merits. **Accordingly, claims 8-11 (invention II) are withdrawn from consideration as
being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.**

Claims 1-4 (invention I) are herein examined.

Claim Rejections - 35 USC § 112 (second paragraph)

3.   In view of the amendments, the previous rejection of claims 1-7 under this section
is withdrawn.

Response to Arguments

4.   In view of the amendments, the previous art rejections are withdrawn. However "Intelligent Paper" used earlier remain the main prior art. Arguments are addressed in the body of the new art rejection below (see page 4).

Claim Rejections - 35 USC § 103

5.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6.   **Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Intelligent Paper" by M. Dymetman, and Max Copperman, in Electronic Publishing, Artistic Imaging and Digital Typography, Proceedings of EP '98, March/April 1998, Springer Verlag LNCS 1375, pp 392-406, in view of Ur, US 6072871.**

"Intelligent Paper" discloses (independent claim 1)

A method and system for providing content in a printed document or publication and for tracking user interaction with an input element on the printed publication, the method comprising the steps of :

a) determining a unique page identity for said publication (page or document) in a computer system (page 392 : unique "code page-id" for each page);

(b) identifying human-readable information for said publication (page 393, 1st paragraph e.g. Louvres in Paris map);

(c) determining a page description for said publication in said computer system, said page description (page 392: "code page-id) comprising:

(i) a description of said human-readable information (page 393, 1st paragraph e.g. Louvres in Paris map);

and

(ii) a description of said input element (page 392 last paragraph : "pointer- loc")
including a zone of said input element on said page (page 392 : "pointer- loc")

and
a description of an associated entity *("Intelligent Paper" discloses sending information from an entity after a request from a user is detected from the user interacting with the input element (see at least p.392-393): this implies an entity has to be associated with the input element and necessarily an identification (i.e. a description) of the entity has to be in the computing system to allow the functionality described in INTELLIGENT PAPER)*;

(d) associating said page identity with said description of said input element (page 392, pair: code page-id, pointer-loc);

(e)-(h) : see below

i) receiving, (in a computer system), from a sensing device, indicating data indicative of a position or movement of the sensing device relative to the printed publication said indicating data being generated by the sensing device using sensed coded data (page 392, pair: code page-id, pointer-loc; page 393, 1st and last paragraphs; ; page 2, 2nd full paragraph, the intelligent paper is equivalent of touch sensitive screen...)

(j)) identifying from the indicating data (data derived from interacting with the pair code page-id -pointer-loc ; page 393, 1st and last full paragraphs) and the page description (page 392, code page-id) whether the user has selected the input element using the sensing device (page 392,from detecting interaction with pair: code page-id, pointer-loc), and if so notifying an associated entity of the selection (Intelligent Paper" discloses sending information after request from a user interacting with the input element over a computing system (see at least p.392-393): notification is implied to effect the sending step).

Printing Steps (e)-(h):

Applicants now agree that INTELLIGENT PAPER teaches printing both human-readable information and coded data in either of 2 ways (see Response page 5 next to last paragraph):

> *"Dymetman appears to hint at the possibility of coded data being either underprinted or overprinted with the human-readable information. In essence this is teaching the skilled person that there are two possibilities (1) printing a coded blank substrate and then overprinting with human-readable information in a subsequent printing step ; or (2) printing human-readable information and then overprinting with coded data in a subsequent printing step. "*

Further Applicants no longer argue, as before, that the same party cannot do both printing. (Applicants now argue printing on demand but Ur below teaches that).

Indeed, INTELLIGENT PAPER teaches printing both coded and human readable data, (page 399 1st paragraph; page 393,last paragraph: the coded data being invisible; page 392-393, last paragraph, and Fig. 2, p. 396: coded data on surface of paper) and nothing, as asserted in the last Office Action, prevents the same party to do both printing.

Thus INTELLIGENT PAPER also discloses a method for printing a publication including:

(e) generating, in a printer, first dot data for coded data using said page identity. said coded data identifying said page identity and a plurality of positions on said publication (page 392, pair: code page-id, pointer-loc);

(f) generating, in a printer, second dot data for said human-readable information using at least part of said page description;

However, it is agreed, INTELLIGENT PAPER does not disclose printing both types of data, simultaneously. That means INTELLIGENT PAPER does not disclose:

(g) compositing the first and second dot data; and
(h) printing the publication wherein the coded data is printed at the same time as printing the human-readable information using the composited dot data.

However Ur discloses:

generating in a printer first dot data for coded data (Fig 2 item 27: coded data; col. 4, lines 41-47)

generating second dot data for human-readable information (Fig 2 item 23: human-readable data)

compositing the dot data in a printer prior to printing (col.4 lines15-18: instructions for printing in the printer, allowing printing both types of data simultaneously, **col. 4, lines 41-47,** read on "compositing");

print interactive publications (col. 4 lines 30-34: interaction with scanners) on demand (col. 4 lines 1-3) with human-readable information and coded data being printed at the same time **(col. 4, lines 41-47).**

Since INTELLIGENT PAPER teaches printing both types of data (p. 399 1st full paragraph), it would have been obvious to one skilled in the art at the time the invention was made to add the Ur's teaching of printing simultaneously both, to INTELLIGENT PAPER, to allow faster printing .

INTELLIGENT PAPER also teaches (claims 2; and 4) the associated entity is a publisher or its computer system. (e.g. page 393: owner of the Paris map content) ;(claims 3) the input element is a hyperlink (p 392, next to last paragraph, "clicks" connotes a hyperlink).

Conclusion

7.   Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Boswell, US 5559933 A discloses distributed enterprise print controller.

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

March 14, 2007

KHL

DONALD L. CHAMPAGNE
PRIMARY EXAMINER